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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,614	03/20/2001	Joseph M. Cannon	CANNON 121-109-65	1498

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DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP  
2101 L STREET NW  
WASHINGTON, DC 20037-1526

EXAMINER
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NGUYEN, JOSEPH D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/811,614

Applicant(s)

CANNON ET AL.

Examiner

Joseph D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-19, 21-37 and 39-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claims 21, and 39 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Regarding claim 21, this claim is depending on the canceling claim 20.

Appropriate correction is required.

Regarding claim 39, this claim is depending on the canceling claim 38.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, and 11, 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "said proximity detector" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "said proximity detector" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "said proximity detector" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 11-15, 18, 24-32, 36, and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriam (6,408,187) in view of Knuth et al. (5,406,618).

Regarding claim 1, Merriam discloses an indication unit for use with a portable wireless device (abstract), the indication unit comprising:

- a motion sensor (abstract, col. 4 lines 1-61) sensing when said portable wireless device has been moved from a stationary position (When portable wireless device can sense the surrounding environment because it has been moved from place to place, which means it senses that it has been moved from place to place or from its stationary position), and for generating (abstract, col. 4 lines 1-61) a signal indicating that said portable wireless device has been moved (abstract, col. 4 lines 1-61);
- a user notification (alert) unit for providing a message indication to a user (abstract, fig. 2-3, col. 4 lines 1-61); and
- responsive to receipt of said signal for activating said user notification unit to notify a user that an incoming call (col. 1 line 56 thru col. 2 line 51). However, Merriam

does not specifically disclose a controller responsive to receipt of said signal for activating said user notification unit to notify a user that a message arrived while said user was presumed not in a vicinity of said portable wireless device.

Knuth et al. teaches a controller responsive to receipt of said signal for activating said user notification unit to notify a user that a message arrived while said user was presumed not in a vicinity of said portable wireless device (abstract, fig. 2, col. 4 line 33 thru col. 5 line 17). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the Merriam system with the teaching of Knuth et al. a controller responsive to receipt of said signal for activating said user notification unit to notify a user that a message arrived while said user was presumed not in a vicinity of said portable wireless device in order to notify the user the messages to be listened.

Regarding claim 2, Merriam further discloses the indication unit of claim 1, wherein the portable wireless device comprises: a telephone (col. 3 lines 1-7).

Regarding claim 3, Merriam further discloses the indication unit of claim 1, wherein the portable wireless device comprises:

- a personal digital assistant (col. 3 lines 1-7). However, Merriam does not specifically disclose the portable wireless device is a personal digital assistant. But, It is obvious to one skilled in the art the Merriam system is not only limited to: a telephone (mobile or land line), a pager, an electronic mail enabled device, a facsimile machine, a computer. Etc. Therefore, it is included a personal digital assistant.

Regarding claim 4, Merriam further discloses the indication unit of claim 1, wherein the portable wireless device comprises: a short message service (SMS) device (col. 3 lines 1-7). However, Merriam does not specifically disclose the portable wireless device is a short message service (SMS) device. But, It is obvious to one skilled in the art the Merriam system is not only limited to: a telephone (mobile or land line), a pager, an electronic mail enabled device, a facsimile machine, a computer. Etc. Therefore, it is included a short message service (SMS) device.

Regarding claim 5, Merriam further discloses the indication unit of claim 1, wherein the portable wireless device comprises: a pager (col. 3 lines 1-7).

Regarding claim 11, Knuth et al. further discloses the indication unit of claim 1, wherein said proximity detector comprises: a voice recognition unit for recognizing a voice of said user when said user has returned to said vicinity of said portable device (abstract, col. 1 line 65 thru col. 2 line 25). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the Merriam system with the teaching of Knuth et al. of voice recognition in order to provide the user the voice message without ever touching the device.

Regarding claim 12, Knuth et al. further discloses the indication unit of claim 1, wherein said user notification unit comprises: a message indicator for informing said user of a pending message (col. 1 line 65 thru col. 2 line 25, and col. 4 lines 33-48). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the Merriam system with the teaching of Knuth et al. of indicating

of the pending message to be heard in order to notify the user the voice message to be heard.

Regarding claim 13, Merriam further discloses the indication unit of claim 12, wherein said portable wireless device comprises: a telephone (col. 3 lines 1-7). However, Merriam does not specifically disclose the pending message is a voice mail.

Knuth et al. teaches the pending message is a voice mail (col. 4 lines 20-48). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the Merriam system with the teaching of Knuth et al. of indicating of the pending message is a voice message to be heard in order to notify the user the voice message to be heard.

Regarding claim 14, Merriam further discloses the indication unit of claim 1, wherein said indication provided to said user comprises: an audible indication (col. 1 lines 56-67, and col. 3 lines 51-60).

Regarding claim 15, Merriam further discloses the indication unit of claim 1, wherein said indication provided to said user comprises: a vibration of said portable wireless device (col. 1 lines 56-67).

Regarding claim 18, Merriam discloses an indication unit for use with a portable wireless device (abstract), the indication unit comprising:

-a motion sensor (abstract, col. 4 lines 1-34) sensing when said portable wireless device has been moved from a stationary position (When portable wireless device can sense the surrounding environment, because it has been moved from place to place,

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which means it senses that it has been moved from place to place or from its stationary position), and for generating (abstract, col. 4 lines 1-34) a signal indicating that said portable wireless device has been moved;

- a user notification (alert) unit for providing a message indication to a user (abstract, fig. 2-3, col. 4 lines 1-61); and

- responsive to receipt of said signal for activating said user notification unit to notify a user that an incoming call (col. 1 line 56 thru col. 2 line 51). However, Merriam does not specifically disclose a controller responsive to receipt of said signal for activating said user notification unit to notify a user that a message arrived while said user was presumed not in a vicinity of said portable wireless device.

Knuth et al. teaches a controller responsive to receipt of said signal for activating said user notification unit to notify a user that a message arrived while said user was presumed not in a vicinity of said portable wireless device (abstract, fig. 2, col. 4 line 33 thru col. 5 line 17). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the Merriam system with the teaching of Knuth et al. a controller responsive to receipt of said signal for activating said user notification unit to notify a user that a message arrived while said user was presumed not in a vicinity of said portable wireless device in order to notify the user the messages to be listened.

Regarding claim 24, this claim is rejected for the same reason as set forth in claim 11.

Regarding claim 25, this claim is rejected for the same



reason as set forth in claim 12.

Regarding claim 26, this claim is rejected for the same reason as set forth in claim 13.

Regarding claim 27, this claim is rejected for the same reason as set forth in claim 14.

Regarding claim 28, this claim is rejected for the same reason as set forth in claim 15.

Regarding claim 29, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 30, this claim is rejected for the same reason as set forth in claim 3.

Regarding claim 31, this claim is rejected for the same reason as set forth in claim 4.

Regarding claim 32, this claim is rejected for the same reason as set forth in claim 5.

Regarding claim 36, Merriam discloses a method for operating a portable wireless device (abstract), said method comprising:

- sensing that said portable wireless device has been moved from a stationary position (When portable wireless device can sense the surrounding environment because it has been move from place to place, which means it senses that it has been moved from place to place or from its stationary position) (abstract, col. 4 lines 1-61).

- detecting when a user has returned to a vicinity of said portable wireless device based on sensed movement of said portable wireless device (abstract, col. 4 lines 1-61). However, Merriam does not specifically disclose notifying said user that a message had occurred while said user was not in said vicinity of said portable wireless device.

Knuth et al. teaches notifying said user that a message had occurred while said user was not in said vicinity of said portable wireless device (abstract, fig. 2, col. 4 line 33 thru col. 5 line 17). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the Merriam system with the teaching of Knuth et al. of notifying user a message had occurred while the user was not in said vicinity in order to remind the user the message needs to be heard.

Regarding claim 41, this claim is rejected for the same reason as set forth in claim 11.

Regarding claim 42, this claim is rejected for the same reason as set forth in claim 12.

Regarding claim 43, this claim is rejected for the same reason as set forth in claim 14.

Regarding claim 44, this claim is rejected for the same reason as set forth in claim 15.

5. Claims 6, 8-10, 19, 21-23, 37, and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriam (6408187) in view of Knuth et al. (5,406,618) and further in view of Dorenbosch (6,505,049).

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Regarding claim 6, in the modify Merriam system, Merriam further discloses the indication unit of claim 1, wherein said (proximity detector) motion sensor (abstract). However, the modify Merriam system does not specifically disclose the motion sensor comprises: a BLUETOOTH.TM.-enabled transceiver for establishing a communication channel with another BLUETOOTH.TM.-equipped device.

Dorenbosch teaches the motion sensor comprises: a BLUETOOTH.TM.-enabled transceiver for establishing a communication channel with another BLUETOOTH.TM.-equipped device (fig. 3, col. 3 lines 25-37). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Merriam system with the teaching of Dorenbosch of Bluetooth in order to transmit and receive information from other devices in a short range.

Regarding claim 8, Dorenbosch further discloses the indication unit of claim 1, wherein said motion sensor comprises: a global positioning system (GPS) receiver to detect motion (col. 1 line 52 thru col. 2 line 42). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Merriam system with the teaching of Dorenbosch of GPS in order to detect movement the wireless device.

Regarding claim 9, Dorenbosch further discloses the indication unit of claim 1, wherein said portable wireless device detects motion by sensing changes in its own position (fig. 5, col. 1 line 52 thru col. 2 line 42). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Merriam system

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with the teaching of Dorenbosch of sensing changes in its own position in order to detect the portable device is in motion or not.

Regarding claim 10, Dorenbosch further discloses the indication unit of claim 1, wherein said portable wireless device comprises a GPS receiver for receiving GPS location information (abstract, fig. 5-7, col. 1 line 52 thru col. 2 line 42); and a receiver for receiving GPS location information transmitted to said portable wireless device from said user (abstract, fig. 5-7, col. 1 line 52 thru col. 2 line 42, and col. 3 line 48 thru col. 4 line 65). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Merriam system with the teaching of Dorenbosch of GPS in order to receive the position information.

Regarding claim 19, this claim is rejected for the same reason as set forth in claim 6.

Regarding claim 21, this claim is rejected for the same reason as set forth in claim 8.

Regarding claim 22, this claim is rejected for the same reason as set forth in claim 9.

Regarding claim 23, this claim is rejected for the same reason as set forth in claim 10.

Regarding claim 37, this claim is rejected for the same reason as set forth in claim 6.

Regarding claim 39, this claim is rejected for the same reason as set forth in claim 9.

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Regarding claim 40, this claim is rejected for the same reason as set forth in claim 10.

6. Claims 16, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriam (6,408,187) in view of Knuth et al. (5,406,618) and further in view of Himmel et al. (6,622,015).

Regarding claim 16, in the modify Merriam system, Merriam further discloses the indication unit of claim 1, wherein said message. However, Merriam does not specifically disclose the message comprises: an appointment reminder.

Himmel et al. teaches the message comprises an appointment reminder (col. 8 lines 7-30). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the Merriam system with the teaching of Himmel et al. of an appointment reminder in order to notify the user of an appointment so he/she does not have to remember.

Regarding claim 33, this claim is rejected for the same reason as set forth in claim 16.

7. Claims 17, and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriam (6,408,187) in view of Knuth et al. (5,406,618) and further in view of Narayanaswami et al. (6,477,117).

Regarding claim 17, in the modify Merriam system, Merriam

further discloses the indication unit of claim 1, wherein: said indication unit is located. However, Merriam does not specifically disclose the indication unit is located on an integrated circuit chip.

Narayanaswami et al. teaches the indication unit is located on an integrated circuit chip (col. 3 lines 51-67). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the Merriam system with the teaching of Narayanaswami et al of an integrated circuit chip in order to reduce the size of the device.

Regarding claim 34, this claim is rejected for the same reason as set forth in claim 17.

Regarding claim 35, this claim is rejected for the same reason as set forth in claim 17.

### ***Response to Amendment***

8. Applicant's arguments with respect to claims 1-44 with the cancellation of claims 7, 20, and 38 have been considered but are moot in view of the new ground(s):

- Merriam teaches a portable wireless device comprises: a notification unit (alert unit) (abstract, col. 1 line 56 thru col. 2 line 22), a motion sensor (abstract, col. 4 lines 1-16) that senses the movement of the device from stationary position. However, Merriam does not disclose the telephone with the voice mail function, and the indication of the voice message has been received. Applicant agrees that, it is very well known in the art, the portable wireless device comprises the voice mail function and

indication to notify the user the message to be heard. This is the reason for the Applicant to modify the Merriam system with the teaching of Knuth et al.

- Knuth et al. teaches the telephone answering machine to receive voice mail when the user is not in the vicinity to answer the call, and when the user is returned in the vicinity, notifying the user the voice mail message to be heard (abstract, fig. 2, col. 4 line 33 thru col. 5 line 17).

- Dorenbosch teaches the portable wireless device comprises: a motion sensor (abstract, fig. 1) to detect the movement of the device with the Bluetooth (col. 3 lines 25-37), and GPS (col. 1 line 52 thru col. 2 line 42) to detect the movement of the portable device from its own position and receiving the position information.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

703 308-9051, (for formal communication intended for entry)

Or:

(703) 305-9509 (for informal or draft communications, please label

"PROPOSED" OR "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA. Sixth floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D Nguyen whose telephone number is (703) 605-1301. The examiner can normally be reached on 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Joseph Nguyen



Mar. 20, 2004



WILLIAM TROST  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600